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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 5,700,654

Issue Date: December 23, 1997

Application No. 08/304,147

Filed: 09/12/1994

For: METHODS AND COMPOSITIONS TO ASSESS OXIDATIVE STRESS IN VITRO

Attorney Docket No: 3002.00005

**RECEIVED**

JUN 19 2006

REQUEST FOR RECONSIDERATION AND PETITION TO REVIVE **OFFICE OF PETITIONS**

MAIL STOP PETITION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Decision on the Petition to Revive, the Decision being mailed April 11, 2006, Paper Number 23. By way of clarification, the original assignee of the present patent was Vanderbilt University. Vanderbilt University licensed the application eventually to Lipoprotein Diagnostics. As licensee, Lipoprotein Diagnostics had responsibility for payment of maintenance fees. The 7½ year maintenance fee was not paid due to unavoidable delay, as clarified below.

The Decision states, on page 3, that "as the patent holder at the time of expiration, it was incumbent on Vanderbilt to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose." Vanderbilt University, as a matter of policy, relies on outside counsel for docketing and notice purposes. Also, Vanderbilt would rely on licensees for this purpose. In the present situation, Vanderbilt University relied on Lipoprotein Diagnostics for docketing and payment of maintenance fees. Lipoprotein Diagnostics, in turn, has no internal docketing system, but rather relies on outside counsel for docketing and payment of maintenance fees and the like. This is common practice of Universities and licensees.

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As discussed below in detail, these processes were in place to assure payment and timely notice was provided from counsel to Mr. Kuhrts, as discussed in the previously submitted Petition. However, as described below in detail, Mr. Kuhrts was unable to be reached by counsel due to technological problems outside their control and outside their knowledge. Notice was appropriately sent by counsel by means used by all counsel, but the communication means failed. A problem with the communication means with certain providers of email services is that the sender is not always given notice of the failure by recipient to receive the email. In addition, as more fully explained below, spam filtering technology can block email messages from senders such that the blocked email would be unbeknownst to the recipient as well as to the sender. Counsel forwarded notices to Lipoprotein Diagnostics by facsimile and received no notice that they were not received. However, Lipoprotein Diagnostics did not receive the notices. Without notice of failure and without instructions from client to proceed, it can only be assumed by counsel that the communications have been received and that the client and receiver of the communication, in this case Lipoprotein Diagnostics, chose not to respond. As previously presented, the fact that counsel sent multiple notices showed prudence by counsel. The fact that many clients respond negatively by providing no response at all, as frustrating as it is to the profession, is a common occurrence. Hence, no response from a client after multiple communications with no notice that the communications are not being received, can only be taken as instructions not to pay a fee.

The Decision on page 4, second full paragraph, questions why it was unavoidable for Petitioner to check whether the maintenance fee had been paid and, if the fee had not been paid, to pay the fee. It further questions why the Petitioner failed to communicate with Vanderbilt University (the patent owner) before the expiration of the '654 patent or before the ending of the time period to file a petition based on unintentional delay, specifically, when no responses from Lipoprotein Diagnostics (the licensee) have been received. The answers to the questions must take into the account the facts of the present situation, as discussed above. Counsel's client was Lipoprotein Diagnostics, not Vanderbilt University.

Vanderbilt University has its own counsel upon which Vanderbilt University relies for docketing as stated by Vanderbilt University. Patent counsel, in many instances, represents a client that could be in any length of a chain of title owners, going to the ultimate inventors, which could be faculty of a university, or employees of a corporation. Counsel relies upon their client for instructions and the client is the ultimate receiver of instructions from others in the title chain. Issues such as confidentiality, privilege, as well as other ethical considerations, require that these communications be kept between counsel and client. Going outside of this relationship puts counsel at high risk of breaching attorney-client confidentiality. Hence, counsel in the present situation relied on their client, Lipoprotein Diagnostics for instructions. As stated herein, due to unavoidable technical glitches in the system that occur throughout the system, counsel was unavoidably unable to communicate with their client Lipoprotein Diagnostics. As stated below, it is critical that the issue addressed herein is the cause of that unavoidable delay.

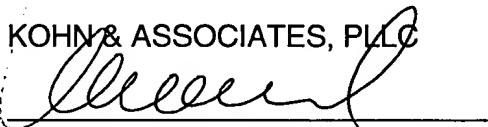
On page 4 of the Decision, it is stated that "Mr. Kuhrt was unable to be reached by counsel, and this was the cause of expiry. However, delay resulting from a failure to keep counsel apprised of the current correspondence address for receiving maintenance fee notices is not unavoidable delay." The Decision quotes Ray v. Lehman, 55 F.3d 606, 609 (Fed Cir 1995). The present situation can be distinguished from the Ray case. In Ray, the sole issue was a lack of communication resulting in non-payment. In the present situation, the lack of communication is not the basis of the unavoidable delay, but was the result of a cause that resulted in the unavoidable delay. The cause was not a simple lack of communication as in the Ray case, but rather was due to spam filtering of the emailed communications. Spam filtering is a technology utilized in most internet communications and easily available to the subscriber. That is, the maintenance fee dates were appropriately docketed as previously evidenced. Communication by counsel for Lipoprotein was sent, appropriately, to Lipoprotein. However, the internet system of Lipoprotein, as well as most internet systems presently in use, operates a spam filter. Similar to what has happened to most users of the internet, communications from counsel

were filtered out as spam emails directed to Lipoprotein. Hence, due to present day ubiquitous technology, totally independent of the actions of the parties involved, and such as in all other acceptable causes for unavoidable delay, counsel for Lipoprotein were unable to reach Mr. Kuhrt of Lipoprotein. It was not a simple matter of counsel not being able to reach the responsible person at Lipoprotein because of docketing or any other typographical or human error, but rather due to technical limitations of our time, communications were not received and therefore payment of the required government fees were unavoidably delayed. This situation, therefore, is totally distinguishable from the Ray case. In view of the above, it is respectfully requested that the Petition to Revive be granted and that the decision to dismiss be reversed.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC

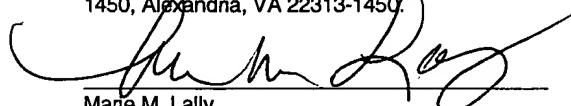
  
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Dated: June 12, 2006

CERTIFICATE OF MAILING

Express Mail Label No.: EV 631 560 783 US  
Date of Deposit: June 12, 2006

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Marie M. Lally